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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,930	09/29/2003	Josef Dietl	13913-064001 / 2002P00240	2375
32864 7590 03/08/2007 FISH & RICHARDSON, P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER HOMAYOUNMEHR, FARID	
			ART UNIT	PAPER NUMBER
			2132	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/08/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/675,930		DIETL, JOSEF	
	<b>Examiner</b>		<b>Art Unit</b>	
	Farid Homayounmehr		2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

Claims 1-17 have been examined.

### **Information Disclosure Statement PTO-1449**

1. No Information Disclosure Statement was submitted by the applicant.

### ***Claim Objections***

2. Claim 8 is objected to because of the following informalities: The claim includes "convert the print out to canonical form". It is assumed that what is meant by the phrase is converting the text (i.e. data) of the print out to canonical form, as it is shown in paragraph 30 of the applicant's specification. A piece of paper with printed matter is considered a print out. It is not clear how a paper with printed matter is to be converted to Canonical form. Examiner suggests changing "converting the print out" to "converting the text of the print out" to improve clarity.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 8, 9, 11-17 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 8 is directed to a computer program

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product embodied in an information carrier. The claim states, "tangibly embodied in an information carrier", however, specification paragraph 36 identifies information carrier as "a propagated signal", which is not tangible. Claim 11 has similar limitations, and claims 9, 12-17 are dependent on 8 and 11.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-4 and 11-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Slater et. al (US Patent Application Publication No. 2002/0069179, filed June 6, 2001).

6.1. As per claim 1, Slater is directed to a computer implemented method, comprising: generating an electronic document in a workflow system (parag. 31 shows generation of an electronic document, and parag. 33 indicates that the invention can be used in applications such as business licenses, which is an example of a workflow system as identified by applicant's specification), the electronic document having content, the electronic document further having a document appearance, the

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appearance representing the content (parag 31 shows that the document is readable by both machine and human, therefore it has a content and appearance. Also see Fig. 2B and associated text); generating one or more control codes for the electronic document as part of a workflow in the workflow system (control codes are the signature blocks added to document as described in parag. 29-32), the one or more control codes being usable to validate the content (parag. 31-34); and creating a print out, the print out including the document appearance, and the one or more control codes (parag. 64 and also 84).

6.2. As per claim 2, Slater is directed to the method of claim 1, further comprising: if the electronic document has an associated approval code, generating a human-readable approval mark for the approval code as part of a workflow in the workflow system; generating a control code for the approval mark, the control code being usable to validate the approval mark; and including the control code for the approval mark in the print out (per parag. 30, the signer of the document examines it (approve) and signs it (approval code), which is verifiable. As mentioned above, Slater teaches printing the document).

6.3. As per claim 3, Slater is directed to the method of claim 2, wherein generating the approval mark comprises:

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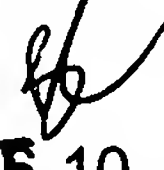
generating a digital signature as the approval code (see response to claim 2); and  
generating a signature image associated with the approval code (when the signature is  
printed, the image of the signature is produced).

6.4. As per claim 4, Slater is directed to the method of claim 1, wherein generating  
one or more control codes comprises: generating a single control code for the print out  
(per paragraph 32, the recorder signature and notary signature may be omitted. Per  
parag 44, one or more persons may sign it. Therefore, it is possible only one person  
signs the document, which means a single signature (control code) is generated and  
printed).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all  
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set  
forth in section 102 of this title, if the differences between the subject matter sought to be patented and  
the prior art are such that the subject matter as a whole would have been obvious at the time the  
invention was made to a person having ordinary skill in the art to which said subject matter pertains.  
Patentability shall not be negated by the manner in which the invention was made.

8. Claims  5-10, and 15-17 are rejected under 35 U.S.C. 103(a) as being  
unpatentable over Slater et al. (US Patent Application Publication No. 2002/0069179,  
filed June 6, 2001).

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8.5. As per claim 5, Slater is directed to the method of claim 1, wherein the print out has one or more physical pages and generating the one or more control codes comprises: generating one or more control codes, each control code corresponding to a page of the one or more physical pages (placing each digital signature in a separate page is a design choice that is obvious to a person skilled in art).

8.6. As per claim 6, Slater is directed to the method of claim 1, wherein generating the one or more control codes comprises: converting the electronic document to a canonical form; and generating the one or more control codes by encrypting the canonical form with a private key, the private key having an associated public key certificate for retrieving a public key associated with the private key (conversion to canonical forms before creating digital signatures were well known in art. Slater suggests use of XML schema to embed digital signatures. One of the features of XML is the capability of converting the XML document to its canonical form according to W3C Canonical XML 1.0 recommendation (as a reference see "Canonical XML Version 1.0" and "Core XML Standards", both of which are attached to this office action). It would have been obvious to a person skilled in art to convert the document to its canonical form and encrypt the canonical form to generate a digital signature. The motivation to do so is faster and more efficient encryption performed on canonical documents, as described, for example, in section 1.2 of "Canonical XML Version 1.0". Use of private and public keys to create and verify digital signatures was well known and widely practiced at the time of invention).



8.7. As per claim 7, Slater is directed to the method of claim 1, further comprising: receiving the print out at the workflow system, the print out having a subsequently added human signature; and validating the received print out within the workflow system (validation of signatures on a paper is known in the prior art as suggested in parag. 6)

8.8. Limitations of claim 8 are directed to receiving and verifying the documents generated in claims 1-7 above. Figs. 4-6 and associated text describe receiving and validating the digital documents.

9. Limitations of claims 9-17 are substantially the same as limitations of claims 1-7 above.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Farid Homayounmehr whose telephone number is 571 272 3739. The examiner can normally be reached on 9 hrs Mon-Fri, off Monday biweekly.



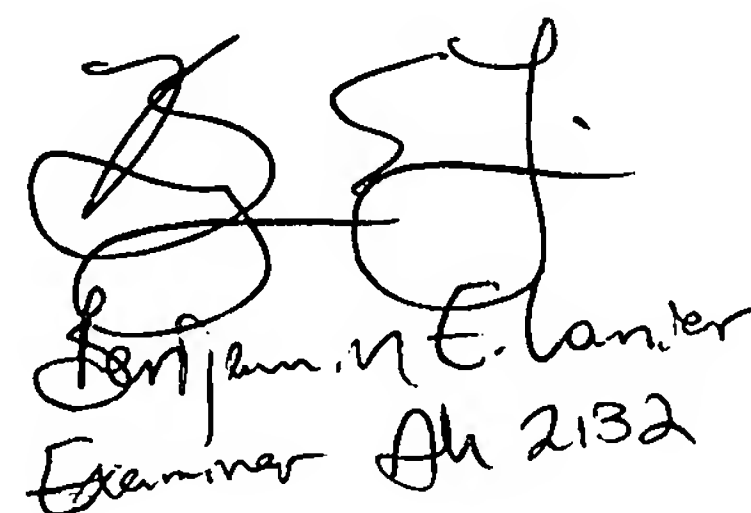
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571) 272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Farid Homayounmehr

Examiner

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Benjamin E. Lanter  
Examiner Art 2132